

REMARKS

Applicant respectfully requests reconsideration of this application as amended.

Per a telephone call with the Examiner on February 16, 2006, a provisional election was made without traverse to prosecute the invention of Group I, claims 1-14 and 27-30. Applicants are hereby affirming this election of claims.

Office Action Rejections Summary

Claim 6 has been objected to for informalities.

Claim 5 has been rejected under 35 U.S.C. §112, second paragraph.

Claims 1-2, 4-5, 9, 12-14 and 27-30 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,571,473 of Fujii (“Fujii”).

Claims 1-2, 4-5, 9, 12-13 and 27-30 have been rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Publication No. 2003/0030188A1 of Spengler (“Spengler”).

Claims 3 and 11 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Spengler in view of U.S. Patent No. 6,482,742 of Chou (“Chou”).

Claims 6 and 10 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Spengler in view of U.S. Patent No. 5,888,433 of Amo (“Amo”).

Claim 7 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Spengler in view of U.S. Patent No. 6,793,476 of Bryja et al. (“Bryja”).

Claim 8 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Spengler in view of U.S. Patent No. 6,989,114 of Korenaga et al. (“Korenaga”).

Status of Claims

Claims 1-14 and 27-30 are pending in the application. Claims 5 and 6 have been amended to more properly define a preexisting claim limitation. The amended claims are

supported by the specification. No claims have been added. No new matter has been added. Claims 15-26 have been canceled, without prejudice.

Claim Rejections

Claim 6 has been objected to. It is submitted that the amendment to claim 6 overcomes the objection.

Claim 5 has been rejected under 35 U.S.C. §112, second paragraph. It is submitted that the amendment to claim 5 overcomes the rejection.

Claims 1-2, 4-5, 9, 12-14 and 27-30 have been rejected under 35 U.S.C. §102(b) as being anticipated by Fujii. It is submitted that claim 1 is patentable over Fujii. Claim 1 recites:

An assembly, comprising:

a heater to pre-heat an embossable film, disposed above a substrate, to an approximate embossing temperature;

 a die assembly having an embossing foil to imprint the embossable film; and

 a heat tunnel disposed between the heater and the die assembly to maintain the approximate embossing temperature

(emphasis added)

As amended claim 27 recites:

An assembly, comprising:

means for pre-heating an embossable film disposed above a substrate to an approximate embossing temperature; and

 means for transporting the substrate to an imprinting die assembly, having an embossing foil, while maintaining the approximate embossing temperature.

(emphasis added)

The Office Action states:

Fujii teaches an assembly comprising: **a heater to pre-heat an embossable film, disposed above a substrate, to an approximate embossing temperature (item 31 – figure 1; column 2, lines 49-51, 63-67)**, a die assembly having an embossing foil to imprint the embossable film (item 4 – figure 1; column 3, lines 64-67; column 4, lines 1-5); and a heat tunnel disposed between the heater and the die assembly to maintain the approximate embossing temperature (item 35 – figure 1; column 3, lines 30-40, 45-58); wherein there is a transporting device for the substrate (figure 1).

With respect to claims 27-30, Fujii teaches an assembly comprising: **a means for pre-heating an embossable film disposed above a substrate to an approximate embossing temperature (item 31 – figure 1; column 2, lines 49-51, 63-67)**; and a means for transporting the substrate to an imprinting die assembly while maintaining the approximate embossing temperature (items 31 and 35 – figure 1; column 3, lines 15-30, 45-50); wherein the apparatus is further comprised of a means for centering the substrate relative to an embossing foil disposed within the imprinting die set (figure 1); wherein there are means for inspecting an embossed pattern on the embossed film and there is means for cooling the substrate (column 3, lines 65-67).

(Office Action, 5/16/06, pp. 4-5)(emphasis added).

Applicant respectfully disagrees with the Office Action's characterization of the cited reference. It is submitted that item the direct heating part 31 of Fujii heats only a portion of the thermoplastic resin sheet while a non-formed part of the thermoplastic resin is **not** heated, as clearly noted in the Abstract of Fujii. In contrast to Fujii, the assemblies of claims 1 and 27 heat the entire embossable film. Therefore, it is submitted that claims 1 and 27, and their respective dependent claims, are patentable over Fujii.

Claims 1-2, 4-5, 9, 12-13 and 27-30 have been rejected under 35 U.S.C. §102(e) as being anticipated by Spengler. It is submitted that claims 1-2, 4-5, 9, 12-13 and 27-30 are patentable over the cited reference.

The Office Action states:

Spengler teaches an assembly comprising: a heater to pre-heat an embossable film, disposed above a substrate, to an approximate embossing temperature (item 50 – figure 1; paragraph 0027), a die assembly having an embossing foil to imprint the embossable film (item 1 – figure 1; paragraphs 0028-0029); and a heat tunnel disposed between the heater and the die assembly to maintain the approximate embossing temperature (item 52 – figure 1; paragraph 0027); wherein there is a transporting device for the substrate (figure 1; paragraph 0046).

With respect to claims 27-30, Spengler teaches an assembly comprising: a means for pre-heating an embossable film disposed above a substrate to an approximate embossing temperature (items 50 and 52 – figure 1; paragraph 0039); and a means for transporting the substrate to an imprinting die assembly while maintaining the approximate embossing temperature (item 60 – figure 1; paragraph 0038); wherein the apparatus is further comprised of a means for centering the substrate relative to an embossing foil disposed within the imprinting die set (item 1 – figure 1; paragraph s0028 – 0029); wherein there are means for inspecting an embossed pattern on the embossed film and there is means for cooling the substrate (paragraphs 0035, 0049-0051).

(Office Action, 5/16/06, pp. 6-7)(emphasis added).

It is respectfully submitted that item 1 of Spengler is “a molding apparatus” and not an embossing foil as recited in each of claims 1 and 27. Therefore, it is submitted that the Office Action has not established that each and every limitation of claims 1 and 27 is disclosed in the cited reference. Each of claims 2, 4-5, 9, 12-13 and 28-30 include the same limitation noted above. As such, applicant respectfully request removal of the rejections of 1-2, 4-5, 9, 12-13 and 27-30 as being anticipated by Spengler.

Claims 3 and 11 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Spengler in view of Chou. It is respectfully submitted that Chou fails to cure the deficiencies of Spengler noted above with respect to independent claim 1 from which claim 3 and claim 11 depend and, therefore, claims 3 and 11 are patentable over the cited references.

Claims 6 and 10 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Spengler in view of Amo. It is respectfully submitted that Amo fails to cure the deficiencies of Spengler noted above with respect to independent claim 1 from which claim 6 and claim 10 depend and, therefore, claims 6 and 10 are patentable over the cited references.

Claim 7 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Spengler in view of Bryja. It is respectfully submitted that Bryja fails to cure the deficiencies of Spengler noted above with respect to independent claim 1 from which claim 7 depends and, therefore, claim 7 is patentable over the cited references.

Claim 8 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Spengler in view of Korenaga. It is respectfully submitted that Korenaga fails to cure the deficiencies of Spengler noted above with respect to independent claim 1 from which claim 8 depends and, therefore, claim 8 is patentable over the cited references

In conclusion, applicants respectfully submit that in view of the arguments and amendments set forth herein, the applicable rejection and objections have been overcome.

If the Examiner believes a telephone interview would expedite the prosecution of this application, the Examiner is invited to contact Daniel Ovanezian at (408) 720-8300.

If there are any additional charges, please charge our Deposit Account No. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: 11/16/06



Daniel E. Ovanezian
Registration No. 41,236

12400 Wilshire Boulevard
Seventh Floor
Los Angeles, CA 90025-1026
(408) 720-8300

FIRST CLASS CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage in an envelope addressed to Commissioner for Patents, PO Box 1450, Alexandria, Virginia 22313-1450.

on November 16, 2006 _____
Date of Deposit

Shannon Tinsley
Name of Person Mailing Correspondence
Shannon Tinsley
Signature

11/16/06
Date